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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/284,563	05/01/2000	Blasius Wilhelm	P-99.0610	2481

7590

09/22/2004

SCHIFF HARDIN LLP  
Patent Department  
6600 Sears Tower  
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EXAMINER
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LEE, SUSAN SHUK YIN

ART UNIT	PAPER NUMBER
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2852

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/284,563	WILHELM ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Susan S. Lee	2852	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 May 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15, 17, 18 and 24-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 6, 7, 9, 13, 31 and 32 is/are rejected.
- 7) ☒ Claim(s) 2, 5, 8, 10-12, 14, 15, 17, 18, 24-30 and 33-35 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 May 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/1/00</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. In addition, the word "means" should be avoided in the title.
2. The abstract of the disclosure is objected to because it does not describe the invention that is now presently claimed. Correction is required. See MPEP § 608.01(b).
3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119 (e) as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except

when the reference is to a prior application of a CPA assigned the same application number.

### ***Drawings***

5. The drawings are objected to because the cross-hatchings of toner in Fig. 9 are incorrectly shown as being made of metal according to MPEP sect. 608.02. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Applicant is reminded that all corrected drawings including the ones sent in by applicant on 5/1/00 should have replacement sheet(s) as described above.

***Claim Objections***

6. Claims 1-15, 17, 18, and 24-35 are objected to because of the following informalities:

As to claim 1, line 1, "the electrophotographic production" lacks antecedent basis.

As to claim 1, lines 7-10, "for changing the used toner container free of ... from the cleaning station" is grammatically incorrect. It also appears to be a run-on sentence.

As to claim 3, line 1, "the adapter unit" lacks antecedent basis.

As to claim 10, line 2, "a drawer" is vague and indefinite since there is a previous recitation of a drawer in claim 9. Is this the same drawer or a different one?

As to claim 12, lines 3-4, "the proximity switch" lacks antecedent basis.

As to claim 14, line 3, "inn" is incorrect.

As to claim 14, line 4, "the printing operations" lacks antecedent basis.

As to claim 24, line 3, "the printed picture elements" lacks antecedent basis.

As to claim 24, lines 3-4, "the printing contrast" lacks antecedent basis.

As to claim 24, lines 4-5, "the number of printed individual pages" lacks antecedent basis.

As to claim 29, line 4, "the printing operation" lacks antecedent basis.

As to claim 31, lines 1-2, "the electrophotographic generation" lacks antecedent basis.

As to claim 31, line 6, "the flow of toner" lacks antecedent basis.

As to claim 31, line 7, "the printing operation" lacks antecedent basis.

Appropriate correction is required.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1, 3, 4, 6, 7, 9, 13, 31, and 32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 19-23 and 25-27 of U.S. Patent No. 6,229,975. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of US Patent No. 6,229,975 read on the instant invention.

9. Claims 1, 19 and 27 of US Patent No. 6,229,975 discloses an apparatus for electrophotographic producing image patterns on a recording medium comprising at least one printing unit, a toner reservoir for supplying toner to the printing unit (claim 1 of US Patent No. 6,229,975); an elimination means for transfer of the used toner collected from a cleaning station to a used toner container (claim 19 of the US Patent No.

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6,229,975) wherein the elimination means can be interrupted in order to enable a replacement of the used toner container free of interruptions of the operation of the printing unit; and a controllable coupling that can be actuated for replacing the used toner container free of printing interruptions is connected between a drive and a conveyor shaft for toner removal from the cleaning station (claim 27 of US Patent No. 6,229,975). These claimed elements read on the instant invention's claims 1, 31, and 32. Claim 20 of US Patent No. 6,229,975 discloses an adapter unit that contains a flexible hose. These elements read on the elements of the instant invention's claim 3. Claim 26 of US Patent No. 6,229,975 discloses that a flow of the used toner from the cleaning station to the adaptor unit can be interrupted in order to enable a replacement of the used toner container that is free of apparatus interruptions. These elements read on the elements of the instant invention's claim 4. Claim 21 of US Patent No. 6,229,975 discloses the flexible hose has a material at its inside that is impenetrable for toner and repels toner; and in that it is preferably manufactured of silicone. These elements read on the elements of the instant invention's claim 6. Claim 22 of US Patent No. 6,229,975 reads on the instant invention's claim 7 where the flexible hose expands frustum-shaped in the direction toward the used toner container. Claim 23 discloses the used toner container is accepted in a drawer seated in running rails, preferably telescoping rails. These elements read on the elements of the instant invention's claim 9. Claim 25 of US Patent No. 6,229,975 discloses a microswitch that monitors the position of the drawer. These elements read on the elements of the instant invention's claim 13.

***Allowable Subject Matter***

Claims 2, 5, 8, 10-12, 14, 15, 17, 18, 24-30, and 33-35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fukunaga et al., Takahashi et al., Hart et al. Ura et al., and Okada disclose art in cleaning units for cleaning off toner. Harris disclose art in a toner container with an adapter.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan S. Lee whose telephone number is 571-272-2137. The examiner can normally be reached on Mon. - Fri., 10:30-8:00, Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Art Grimley can be reached on 571-272-2136 or 571-272-2800 (Ext. 52). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Susan S. Lee  
Primary Examiner  
Art Unit 2852

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